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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,285	12/19/2000	Robert Schneider	10002475-1	6494

7590 08/12/2005

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EXAMINER

LAZARO, DAVID R

ART UNIT PAPER NUMBER

2155

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/741,285	SCHNEIDER, ROBERT	
	<b>Examiner</b>	<b>Art Unit</b>	
	David Lazaro	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/1/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This office action is in response to the RCE filed 06/01/2005.
2. Claims 1, 11 and 21 were amended.
3. Claims 1-22 are pending in this office action.

### ***Response to Amendment***

4. The rejections of claims 1-22 under 35 U.S.C. §112, second paragraph, as being indefinite, are withdrawn. Please note, however, that new rejections have been made under 35 U.S.C. §112, second paragraph.
5. The rejections of claims 1-22 under 35 U.S.C. §101, as being directed to non-statutory subject matter, are withdrawn.
6. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 4, 10, 11 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the

elements. See MPEP § 2172.01. The omitted elements are: Elements related to a printing module and printing device as described on pages 11-12 of the specification, for example. Claim 4 states the phrase, "the personal identifier is a bar-code that is visibly displayed on a printed document containing by the feedback information". There is no subject matter directed to any printing module or device in claim 1 (on which claim 4 depends) and claim 4 does not provide such subject matter. Therefore it is unclear as to how the "printed document" came to be part of the claimed system when there is no claimed printing module or device (or equivalents with respect to the specification). Furthermore, while an assumption is made that the document is related to the content, the claim language does not particularly point out if that is the case. The language "containing by the feedback information" is also unclear in terms of what applicants are attempting to claim.

10. Regarding claims 10 and 20, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

11. Claim 11 recites the limitation "the system" in the last 2 lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-3, 5-18, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,477,575 by Koeppel et al. (Koeppel).

14. With respect to Claim 1, Koeppel teaches a system implemented in a computing environment comprising: a plurality of content providers (Col. 1 lines 26-43, Col. 5 line 66 - Col. 6 line 4 and Col. 9 lines 11-18); one or more content handlers distributed throughout a network and coupled to one or more of the plurality of content providers through the network (Col. 5 lines 48-51, Col. 6 lines 23-27 and Col. 7 lines 50-55), to receive content from one or more content providers (Col. 5 lines 48-51, Col. 6 lines 23-27 and Col. 7 lines 50-55); and a feedback generator coupled to the content handlers and configured to review the content and dynamically and automatically gather and assemble targeted marketing feedback information based on the review and append the feedback information to the received content (Col. 7 lines 50-55 and Col. 6 lines 27-44) before forwarding the content to a requesting user (Col. 7 lines 50-55 and Col. 6 lines 27-44) and further configured to embed a personal identifier of the requesting user in the feedback information that uniquely identifies the requesting user to allow the system to automatically identify users sending feedback information back to the system (Col. 10 line 43 - Col. 11 line 10).

15. With respect to Claim 2, Koeppel teaches all the limitations of Claim 1 and further teaches wherein the content handlers generate the feedback information based, at least in part, on the received content (Col 12 lines 31-60 and Col. 13 lines 44-57).

16. With respect to Claim 3, Koeppel teaches all the limitations of Claim 1 and further teaches wherein the content handlers receive the feedback information from a third-party content provider to append to received content, based at least in part on the received content (Col. 14 lines 50-62 and Col. 2 lines 52-67).

17. With respect to Claim 5, Koeppel teaches all the limitations of Claim 1 and further teaches the content providers comprising: formatting services, to receive content from a content provider and generate feedback information to append to the received content based, at least in part, on the received content (Col. 6 lines 23-44, Col. 7 lines 50-55) and Col. 10 line 43 - Col. 11 line 20).

18. With respect to Claim 6, Koeppel teaches all the limitations of Claim 1 and further teaches wherein the feedback information is a form which the requesting user can manipulate to automatically order product, services and/or content from one or more of the plurality of content providers or purveyors associated with the feedback information (Col. 12 line 61 - Col. 13 line 21 and Col. 9 lines 11-19).

19. With respect to Claim 7, Koeppel teaches all the limitations of Claim 1 and further teaches wherein the feedback information, regardless of source, is related to the content of the received content (Col. 14 lines 50-62 and Col. 2 lines 52-67).

20. With respect to Claim 8, Koeppel teaches all the limitations of Claim 1 and further teaches a computing device, the computing device including, a storage device having

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stored therein a plurality of executable instructions; and an execution unit, coupled to the storage device, to execute at least a subset of the plurality of executable instructions to implement one or more of the content handlers (Col. 5 line 66 - Col. 6 line 4 and Col. 6 lines 23-27).

21. With respect to Claim 9, Koeppel teaches all the limitations of Claim 1 and further teaches wherein the content handler receives user modified feedback content and initiates an action based, at least in part, on the user-modified feedback content (Col. 12 line 61 - Col. 13 line 28, Col. 8 lines 3-45, and Col. 9 lines 11-19).

22. With respect to Claim 10, Koeppel teaches all the limitations of Claim 1 and further teaches the action reflects the user-modified feedback content and may include one or more of ordering a product, issuing a request to a content provider for additional information, scoring an exam and reporting results to the user and/or content provider, and the like (Col. 12 line 61 - Col. 13 line 28, Col. 8 lines 3-45, and Col. 9 lines 11-19).

23. With respect to Claim 11, Koeppel teaches a method implemented in a computing environment comprising: receiving content from a content provider from a network while in route to a requesting user in response to a request for such content (Col. 5 lines 48-51, Col. 6 lines 23-27 and Col. 7 lines 50-55); reviewing the content (Col. 7 lines 50-55 and Col. 6 lines 27-44); gathering and assembling target marketing feedback information based on the review (Col. 7 lines 50-55 and Col. 6 lines 27-44); appending the feedback content dynamically and automatically to the received content before forwarding the received content with appended feedback content to the requesting user (Col. 7 lines 50-55 and Col. 6 lines 27-44); and embedding a personal

identifier of the requesting user in the feedback information that uniquely identifies the requesting user to allow the system to automatically identify users sending feedback information back to the system (Col. 10 line 43 - Col. 11 line 10).

24. With respect to Claim 12, Koeppel teaches all the limitations of Claim 11 and further teaches wherein appending feedback content comprises: generating feedback content based, at least in part, on the received content (Col 12 lines 31-60 and Col. 13 lines 44-57); and inserting the feedback content in to the received content in accordance with formatting preferences of the content provider (Col. 13 lines 44-57).

25. With respect to Claim 13, Koeppel teaches all the limitations of Claim 11 and further teaches wherein appending feedback content comprises: receiving feedback content from a third-party provider (Col. 14 lines 50-62 and Col. 2 lines 52-67), and inserting the feedback content in to the received content in accordance with formatting preferences of the content provider and/or the third-party provider (Col. 13 lines 44-57).

26. With respect to Claim 14, Koeppel teaches all the limitations of Claim 11 and further teaches wherein appending feedback content comprises: receiving feedback content from the content provider and inserting the feedback content in to the received content in accordance with formatting preferences of the content provider (Col 12 lines 31-60 and Col. 13 lines 44-57).

27. With respect to Claim 15, Koeppel teaches all the limitations of Claim 11 and further teaches wherein the feedback content comprises an interactive form, enabling a user to respond to the feedback content (Col. 12 line 61 - Col. 13 line 21 and Col. 9 lines 11-19).



28. With respect to Claim 16, Koeppel teaches all the limitations of Claim 15 and further teaches wherein the interactive form is an examination over material covered in the received content (Col. 8 lines 3-45 and Col. 9 lines 1-19).

29. With respect to Claim 17, Koeppel teaches all the limitations of Claim 15 and further teaches wherein the interactive form is a request for further information regarding the received content (Col. 8 lines 3-45 and Col. 9 lines 1-19).

30. With respect to Claim 18, Koeppel teaches all the limitations of Claim 11 and further teaches receiving user-modified feedback content from the user; and initiating an action on behalf of the user based, at least in part, on the user-modified feedback content (Col. 12 line 61 - Col. 13 line 28, Col. 8 lines 3-45, and Col. 9 lines 11-19).

31. With respect to Claim 20, Koeppel teaches all the limitations of Claim 18 and further teaches wherein initiating an action comprises one or more of issuing a message to a content provider for additional information, ordering a product for delivery to the user, scoring an exam and reporting results to the user and/or generator of the feedback content, and the like (Col. 12 line 61 - Col. 13 line 28, Col. 8 lines 3-45, and Col. 9 lines 11-19).

32. With respect to Claim 21, Koeppel teaches a storage medium usable in a computer system comprising a plurality of executable instructions at least a subset of which, when executed, implement a content handler with integrated feedback facilities (Col. 6 line 23-43), to receive content from one or more content providers from a network while in route to a requesting user (Col. 5 lines 48-51, Col. 6 lines 23-27 and Col. 7 lines 50-55), and a feedback generator coupled to the content handlers and

configured to review the content and dynamically and automatically gather and assemble targeted marketing feedback information based on the review (Col. 7 lines 50-55 and Col. 6 lines 27-44) and append the feedback information to the received content before forwarding the content to a requesting user (Col. 7 lines 50-55 and Col. 6 lines 27-44) and further configured to embed a personal identifier of the requesting user in the feedback information that uniquely identifies the requesting user to allow the system to automatically identify users sending feedback information back to the system (Col. 10 line 43 - Col. 11 line 10).

***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 4, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koeppel in view of U.S. Patent 6,873,336 by Sailus et al. (Sailus).

35. With respect to Claim 4, Koeppel teaches all the limitations of Claim 1 and further teaches wherein the content handlers receive the feedback information from the content providers (Col. 6 lines 23-44, Col. 7 lines 50-55 and Col. 10 line 43 - Col. 11 line 20).

Koeppel does not explicitly disclose wherein the personal identifier is a bar-code that is visibly displayed on a printed document. Sailus teaches a personal identifier in the form of a bar-code can be visibly displayed on a printed document. This allows, for

example, a printed order form to be easily scanned to identify the personal information of the customer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Koeppel and modify it as indicated by Sailus such that the system further comprises wherein the personal identifier is a bar-code that is visibly displayed on a printed document containing by the feedback information. One would be motivated to have this, as a quick and efficient manner of obtaining personal information is desirable (In Sailus: Col. 6 line 4-10).

36. With respect to Claim 19, Koeppel teaches all the limitations of Claim 18 and further teaches wherein the user-modified feedback content is received at a network address determined by the feedback generator (Col. 1 lines 51-61 and Col. 6 lines 16-43).

Koeppel does not explicitly disclose wherein the personal identifier is a bar-code that is visibly displayed on a printed document. Sailus teaches a personal identifier in the form of a bar-code can be visibly displayed on a printed document. This allows, for example, a printed order form to be easily scanned to identify the personal information of the customer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Koeppel and modify it as indicated by Sailus such that the method further comprises wherein the personal identifier is a bar-code that is visibly displayed on a printed document containing by the feedback

information. One would be motivated to have this, as a quick and efficient manner of obtaining personal information is desirable (In Sailus: Col. 6 line 4-10).

37. With respect to Claim 22, Koeppel teaches all the limitations of Claim 21 and wherein the feedback content generator dynamically generates feedback content to append to received content based, at least in part on the received content (Col. 14 lines 50-62 and Col. 2 lines 52-67).

Koeppel does not explicitly disclose wherein the personal identifier is a bar-code that is visibly displayed on a printed document. Sailus teaches a personal identifier in the form of a bar-code can be visibly displayed on a printed document. This allows, for example, a printed order form to be easily scanned to identify the personal information of the customer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the storage medium disclosed by Koeppel and modify it as indicated by Sailus such that the storage medium further comprises wherein the personal identifier is a bar-code that is visibly displayed on a printed document containing by the feedback information. One would be motivated to have this, as a quick and efficient manner of obtaining personal information is desirable (In Sailus: Col. 6 line 4-10).

### ***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


39. U.S. Patent 5,999,912 by Wodarz et al. "Dynamic advertising scheduling, display, and tracking" December 7, 1999. Disclose the dynamic insertion of advertising based on an ad tag associated with the requested content.

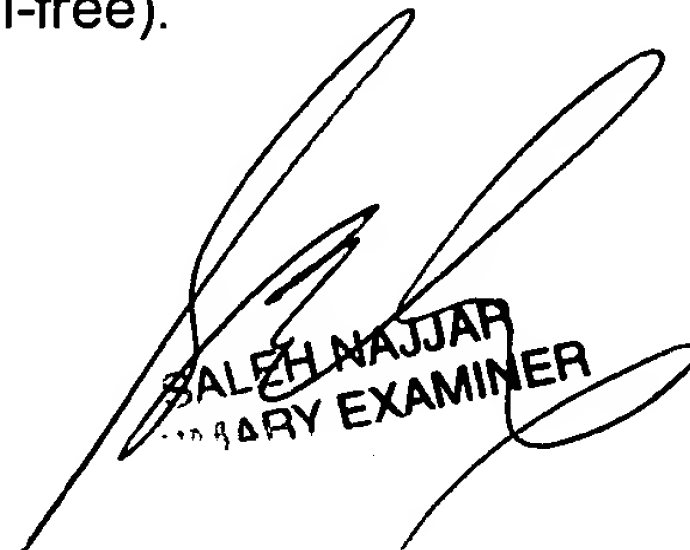
40. U.S. Patent 6,654,725 by Langheinrich et al. "System and method for providing customized advertising on the world wide web" November 25, 2003. Discloses insertion of a customized advertisement that matches page content or search topic.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David Lazaro  
August 10, 2005

  
SALEH NAJJAR  
PRIMARY EXAMINER